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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/772,848

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John M. Barrie

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10/06/2008

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EXAMINER

VAUGHN, GREGORY J

ART UNIT

PAPER NUMBER

2178

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DELIVERY MODE

10/06/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/772,848	<b>Applicant(s)</b> BARRIE ET AL.	
	<b>Examiner</b> GREGORY J. VAUGHN	<b>Art Unit</b> 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 5-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Action Background***

1. This action is responsive to the amendment filed on 6/24/2008.
2. Applicant has amended claims 1 and 7; and canceled claims 2, 3, 11 and 12. Claims 4 and 13 were previously canceled.
3. Claims 1 and 5-10 are pending in the case; claims 1 and 7 are independent claims.
4. The rejection of claims 2, 3, 11 and 12, rejected as described in the office action dated 4/2/2008, is withdrawn in view of the canceled claims.

### ***Priority***

5. As previously noted, applicant's claim for domestic priority under 35 U.S.C. 119(e) of US provisional application 60/447,379, filed 2/13/2003 is acknowledged.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

7. Claims 1 and 5-10 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Shanahan et al. US Patent Publication 2005/0022114, filed 12/5/2001, published 1/27/2005 (hereinafter Shanahan).

8. **Regarding independent claims 1 and 7**, Shanahan discloses receiving a document over an electronic communication network. Shanahan recites: *"In one operational embodiment, multifunctional (i.e., fax, scan, print, store, email) device 512 scans in a document 614"* (paragraph 179). Shanahan discloses the multifunctional device 512 as part of an electronic communication network in Figure 5, reference sign 516 (shown as "Intranet"). Shanahan discloses converting the formatted document into a standardized formatted document. Shanahan recites: *"document content is detected and converted to a digital form"* (paragraph 179). Shanahan discloses permitting a user to add contextual markups to the formatted document to generate a markup document. Shanahan recites: *"Annotate" is used herein to mean to create a reference between an entity in a document, or region of a*

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*document, and some set of links, text segment, images, or embedded data"* (paragraph 117) and *"Document "mark-up" is used herein to mean the annotation applied to a document"* (paragraph 120). Shanahan discloses displaying the mark-up document. Shanahan recites: *"a visualization and interaction system that allows various levels of display and interaction of metadata-enhanced documents"* (paragraph 146).

Shanahan discloses adding contextual markups (described as annotate), as described above. Shanahan discloses user added annotations in a variety of forms, including *"text segments"*, as described above. Shanahan fails to explicitly describe the annotations as editorial comments, corrections, annotations, symbols or comments added by a user, however, editorial comments, corrections, annotations, symbols and comments are all text segments, and a user could use the text segment to contain editorial comments, corrections, annotations, symbols and comments. Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made to use the annotation text segments, as taught by Shanahan for editorial comments, corrections, annotations, symbols and comments in order *"to enrich the documents while facilitating reading comprehension, understanding relationships with other documents, and content creation"* (Shanahan, paragraph 3).

Shanahan discloses the standardized document as an image file. Shanahan recites: *"A "document" is used herein to mean an electronic (e.g., digital) or physical (e.g., paper) recording of information. In its electronic form, a document may include*

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*image data, audio data, or video data. Image data may include text, graphics, or bitmaps*" (paragraph 119) and *"continuous-education document service request. For example, a textbook document"* (paragraph 145).

Shanahan discloses the contextual markups are added to an invisible image that maps to said image file. Shanahan recites: *"A meta-document 100, for example, may be given a personality 104 that is: ... (c) private: marked to keep the document's metadata invisible to other documents"* (paragraph 149).

9. **Regarding dependent claim 5**, Shanahan discloses storing information related to the document in a database. Shanahan recites: *"FIG. 45 is a flow diagram for creating and updating an entity database dynamically from the document information space"* (paragraph 59).
10. **Regarding dependent claim 6**, Shanahan discloses the information consisting of an identifier of a submitter. Shanahan recites: *"this invention relates to the use of a digitally readable personality identifier in a meta-document management system"* (paragraph 3).
11. **Regarding dependent claims 8 and 9**, Shanahan discloses the standardized document as an image file (claims 2 and 11) as a manuscript (claim 8) and an educational assignment (claim 9). Shanahan recites: *"A "document" is used herein to mean an electronic (e.g., digital) or physical (e.g., paper) recording of information. In its electronic form, a document may include image data, audio data, or video data. Image data may include text, graphics, or bitmaps"* (paragraph 119) and

*“continuous-education document service request. For example, a textbook document”* (paragraph 145).

12. **Regarding dependent claim 10**, Shanahan discloses the Internet in Figure 2 at reference sign 221.

### ***Response to Arguments***

13. Applicant's arguments filed 6/24/2008 have been fully considered but they are not persuasive.
14. Regarding the rejection of claim 1, applicant argues: *“a digital form is not the same as an image”* (page 4, third paragraph, of the response filed 6/24/2008). Applicant is directed to the rejection of claim 1, as described above. Applicant is interpreting the following section of Shanahan:

*“In one operational embodiment, multifunctional (i.e., fax, scan, print, store, email) device 512 scans in a document 614 with embedded data 612. Once the personality identifier and document content is detected and converted to a digital form, the multifunctional device 512 transmits them to the meta-document server 200”* (paragraph 179 – emphasis added).

The examiner has interpreted the cited section of Shanahan in combination with the definition set out by Shanahan:

*“A “document” is used herein to mean an electronic (e.g., digital) or physical (e.g., paper) recording of information. In its electronic form, a document may include image data, audio data, or video data. Image data may include text, graphics, or bitmaps”* (paragraph 19).

As described above, digital form, as described by Shanahan, includes image data, and since the embedded data is converted to “*digital form*” the embedded data is converted into its electronic form, which includes image data.

### ***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone



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number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Stephen S. Hong/  
Supervisory Patent Examiner, Art  
Unit 2178

/Gregory J. Vaughn/  
Patent Examiner  
September 30, 2008